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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,404	03/31/2004	Samuel Achilefu	1515.1:H US (073979.14)	5388

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EXAMINER

PERREIRA, MELISSA JEAN

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

03/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,404

Applicant(s)

ACHILEFU ET AL.

Examiner

MELISSA PERREIRA

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 17, 19, 23 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) 27-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 17, 19 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1,17,19,23 and 27-36 are pending in the application. Claims 27-36 are withdrawn from consideration.

Response to Arguments

1. Applicant's arguments with respect to claims 1,17,19 and 23 have been considered but are moot in view of the new ground(s) of rejection.

New Grounds of Rejection Necessitated by the Amendment

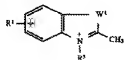
Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,17,19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajagopalan et al. (US 5,672,333) in view of Huynh et al. (US 5,750,722).

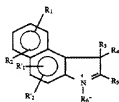
4. Rajagopalan et al. (US 5,672,333) discloses the indole compounds below which are used in the preparation of cyanine dyes where R¹ is H, C₁₋₁₀ hydroxyalkyl, C₁₋₁₀ alkoxy, halogen, nitro, etc.; R³ is C₁₋₁₀ aryl, C₁₋₁₀ alkoxyalkyl, etc.; W¹ is CR⁹R¹⁰ where R⁹ and R¹⁰ may be defined in the same manner as R³, such as C₁₋₁₀ aryl, C₁₋₁₀ alkoxyalkyl, etc. (abstract; column 2, lines 28-67; column 3, lines 18-43).



5.

6. Rajagopalan et al. does not disclose that R^3 and R^9 and R^{10} , corresponding to Y_1 and R_c and R_d of the instant claims, are selected from the group consisting of C_{1-10} polyhydroxyaryl, etc.

7. Huynh et al. (US 5,750,722) discloses of the benz[e]indole compounds below which are used for the synthesis of Indocyanine Green where R_1 , R_2 , R_1' , R_2' , R_3 , R_4 , and R_5 are H, C_{1-12} alkyl (i.e. methyl), aryl or aroxyl groups (not excluding polyhydroxyaryl), etc.; R_6 is alkoxy, C_{1-4} sulfoalkyl, etc. (abstract; column 1, lines 8-42).



8.

9. At the time of the invention it would have been obvious to one skilled in the art to substitute the R_3 , R_4 aroxyl groups (not excluding polyhydroxyaryl) of Huynh et al. for the R^9 and R^{10} groups for the compounds of Rajagopalan et al. as a.) there are a finite number of substituents listed for R_3 , R_4 of Huynh et al., b.) the compounds of both disclosures have equivalent core ring structures where the substituents (R_3 , R_4 of Huynh et al. and R^9 and R^{10} groups of Rajagopalan et al.) are attached at the same carbon of the core ring structure and c.) both disclosures are drawn to the same utility, such as preparation of cyanine dyes. The substitution of the R_3 , R_4 aroxyl groups (not excluding polyhydroxyaryl) of Huynh et al. for the R^9 and R^{10} groups for the compounds of

Rajagopalan et al. would yield predictable results, such as the generation of new cyanine dyes.

10. Rajagopalan et al. teaches that R^9 and R^{10} may be defined in the same manner as R^3 and therefore at the time of the invention it would also have been obvious to one skilled in the art to utilize the aroxyl groups (not excluding polyhydroxyaryl) for the R^3 group as well as the R^9, R^{10} groups of Rajagopalan et al.

Conclusion

11. No claims are allowed at this time.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA PERREIRA whose telephone number is (571)272-1354. The examiner can normally be reached on 9am-5pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

/Melissa Perreira/
Examiner, Art Unit 1618